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Written Description: Protecting the Quid Pro Quo Since 1793

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Written Description: Protecting the Quid Pro Quo Since 1793

Jacob Adam Schroeder*

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INTRODUCTION

The growth of the patent system in the last quarter of a century in this country has reached a stage in its progress where the variety and magnitude of the

interests involved require accuracy, precision, and care in the preparation of all the papers on which the patent is founded. . . . The developed and improved condition of the patent law, and of the principles which govern the exclusive rights conferred by it, leave no excuse for ambiguous language or vague descriptions. . . . It seems to us that nothing can be more just and fair, both to the patentee and to the public, than that the former should understand, and correctly describe, just what he has invented, and for what he claims a patent.¹

Imagine you are Elwood Haynes, the inventor of the first true American automobile in 1894.² Being the first American to invent an automobile designed to run entirely on its own power, you quickly make plans to build a factory in Kokomo, Indiana to ramp up production. You would be shocked, therefore, to learn that George Selden, a patent attorney from Rochester, NY, had already obtained a patent filed in 1879 not just for an internal combustion engine, but for its use on four-wheeled vehicles as well.³ To make matters worse, George Selden was going around to every American car manufacturer and demanding that they pay a royalty to his patent or else meet him in the court room.⁴ Although a group of car manufacturers, including Henry Ford, eventually stood up to Selden in court and won a judgment of non-infringement of Selden's patent,⁵ it is still amazing to consider the deterrent effect of Selden's conduct on automobile innovation.⁶

¹ Merrill v. Yeomans, 94 U.S. 568, 573–74 (1876).

² See W.C. MADDEN, HAYNES-APPERSON AND AMERICA'S FIRST PRACTICAL AUTOMOBILE: A HISTORY 3 (McFarland & Co. Inc., 2003).

³ See U.S. Patent No. 549,160 (filed May 8, 1879) (issued Nov. 5, 1895).

⁴ See Robert P. Merges & Richard R. Nelson, *On the Complex Economics of Patent Scope*, 90 COLUM. L. REV. 839, 889 (1990).

⁵ See *Columbia Motor Car Co. v. C.A. Durer & Co.*, 184 F. 893, 915 (2d Cir. 1911).

⁶ See Merges & Nelson *supra* note 4, at 890 (“Law suits based on [Selden’s patent] surely did absorb considerable time and attention of people like Henry Ford, whose production methods revolutionized the industry. Perhaps more importantly smaller firms may have been put off by the threat of suit. At this early stage in the history of the technology, those that left the industry or chose not to enter may well have taken valuable improvements with them.”); see also *Columbia Motor Car Co.*, 184 F. at 895 (“While he withheld his patent, the public learned from independent inventors all that it could teach. For the monopoly granted by his patent he had nothing to offer in return.”).

Indeed, Selden could be described as an overreaching inventor, who thought up an improvement to a one-cylinder engine and later obtained a patent to all uses of an internal combustion engine for use in an automobile. In the words of the court: “[t]he public gained absolutely nothing from his invention, whatever it was. From the point of view of public interest it were [sic] even better that the patent had never been granted.”⁷

To those unfamiliar with patent law, it may come as a surprise that an inventor can file for a patent without actually making the thing he alleges to have invented. However, to the United States Patent and Trademark Office (“USPTO”), filing a patent application is as good as actually constructing the invention in real life.⁸ That being so, what ensures that a patentee does not obtain a patent to something he has not really invented? The answer is primarily two doctrines, both contained within 35 U.S.C. § 112, ¶ 1.⁹ The first is the “written description” requirement and the second is the “enablement” requirement. These doctrines work together to ensure that when the United States Patent and Trademark Office grants a patent to an inventor, the public gets something in return.¹⁰

On August 21, 2009, the Court of Appeals for the Federal Circuit granted Ariad Pharmaceuticals’ petition for rehearing en banc and requested briefs addressing: 1) “[w]hether 35 U.S.C. § 112, [¶] 1, contains a written description requirement separate from an enablement requirement;”¹¹ and 2) if so, “what is the scope and

⁷ *Columbia Motor Car Co.*, 184 F. at 895.

⁸ See U.S. PATENT & TRADEMARK OFFICE, U.S. DEP’T OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE § 2138.05 (8th ed. 2008).

⁹ 35 U.S.C. § 112 (2006).

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Id.

¹⁰ See *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 922 n.5 (Fed. Cir. 2004).

¹¹ *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 595 F.3d 1329, 1330 (Fed. Cir. 2009) (granting the petition for rehearing en banc).

purpose of the requirement?”¹² In considering these issues, the Federal Circuit reexamined a doctrine that traced its origins back to at least the Patent Act of 1793.¹³ In the decade leading up to *Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co.*,¹⁴ a number of judges on the Federal Circuit had begun to question the existence and scope of the written description requirement in their dissents.¹⁵ By accepting the en banc petition, the court decided that now was the proper time to resolve these questions. On March 22, 2010, the court finally answered the questions: “[w]e now reaffirm that § 112, first paragraph, contains a written description requirement separate from enablement” and “[t]hat the adequacy of the [written] description of the manner and process of *making* and *using* the invention is judged by whether that description enables one skilled in the art to *make* and *use* the same”¹⁶

Writing for the majority in *Ariad*, Judge Lourie explained that the written description requirement ensures that the public gets its fair share of the bargain when an inventor is granted a patent and serves a related yet distinct purpose from the undisputed enablement requirement:¹⁷ it ensures that the inventor actually invented the subject matter claimed by his or her patent.¹⁸ This Article argues that in so holding the *Ariad* court properly resolved this dispute. Part I of this Article will first discuss the simplified

¹² *Id.*

¹³ See *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1345 (Fed. Cir. 2010) (en banc).

¹⁴ 598 F.3d 1336, 1345 (Fed. Cir. 2010) (en banc).

¹⁵ See, e.g., *id.* at 1361–62 (Rader, J., dissenting in part and concurring in part) (citing *Lizardtech, Inc. v. Earth Res. Mapping, Inc.*, 433 F.3d 1373, 1376 (Fed. Cir. 2006) (Rader, J., dissenting from denial of rehearing en banc)); *Univ. of Rochester v. G.D. Searle & Co.*, 375 F.3d 1303, 1307 (Fed. Cir. 2004) (Rader, J., dissenting from denial of rehearing en banc); *id.* at 1325 (Linn, J., dissenting from denial of rehearing en banc); *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 976 (Fed. Cir. 2002) (Rader, J., dissenting from denial of rehearing en banc); *id.* at 987 (Linn, J., dissenting from denial of rehearing en banc).

¹⁶ *Ariad*, 598 F.3d at 1340, 1344.

¹⁷ See *id.* at 1345 (“[A] separate requirement to describe one’s invention is basic to patent law. Every patent must describe an invention. It is part of the *quid pro quo* of a patent; one describes an invention, and, if the law’s other requirements are met, one obtains a patent. The specification must then, of course, describe how to make and use the invention (i.e., enable it), but that is a different task.”).

¹⁸ See *id.* at 1351 (“[T]he specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.”).

facts of *Ariad*. Part I will then discuss the role of the enablement and the written description requirements in the United States Patent System and trace the historical development of the written description requirement from the early Supreme Court decisions up through the modern day Federal Circuit decisions. Part II will discuss the three main viewpoints of the Federal Circuit on written description as represented by Chief Judge Rader,¹⁹ Judge Lourie, and Judge Linn. Part III of this Article will first analyze the historical purpose of the written description requirement and then analyze some common misconceptions and mischaracterizations of the written description requirement. Part III will then discuss some common ground among the judges of the Federal Circuit. This Article concludes with suggestions for the role the written description requirement should play going forward.

I. DISCUSSION

A. *Simplified Factual Background of Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co.*

The technology at issue in *Ariad* involves the discovery of a molecule named NF- κ B.²⁰ This molecule is akin to an “all-purpose cellular paramedic.”²¹ When a cell in the body detects a harmful presence, such as bacteria, NF- κ B is “activated.”²² The activated NF- κ B travels to the nucleus of the cell, where it attaches to its binding site in the DNA, and activates the production of, among other things, certain cytokines.²³ These cytokines help the cell survive that harmful presence, but the cytokines themselves can be toxic in excess.²⁴ Once the original

¹⁹ Judge Rader assumed the duties of Chief Judge on June 1, 2010. *Randall R. Rader, Chief Judge*, U.S. COURT OF APPEALS FOR THE FED. CIR., http://www.ca9.uscourts.gov/index.php?option=com_content&view=article&id=132&Itemid=24 (last visited Dec. 17, 2010). For the sake of consistency this Article will refer to him as Chief Judge Rader throughout.

²⁰ *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 560 F.3d 1366, 1369 (Fed. Cir. 2009), *aff'd en banc*, 598 F.3d 1336 (Fed. Cir. 2010).

²¹ *Id.*

²² *Id.*

²³ *Id.*

²⁴ *Id.*

harmful presence is eliminated, such as when the bacterial infection is cured, NF-KB activity decreases and the cell returns to its original state.²⁵

The owners of U.S. Patent No. 6,410,516 (“the ’516 patent”) identified NF-KB and its pathway for entering the nucleus and activating the production of cytokines.²⁶ As stated above, excessive NF-KB activation can, in itself, result in heightened toxicity to the cell if left unchecked. For this reason, the inventors of the ’516 patent hypothesized that if NF-KB activation could be reduced, it might be possible to reduce these toxic side effects.²⁷ Based on this hypothesis, Ariad claimed three methods of reducing NF-KB activation in the ’516 patent.²⁸ In general, Ariad proposed three hypothetical methods of reducing NF-KB activation by: 1) holding NF-KB in an inactive state by introducing its natural inhibitor; 2) having another molecule bind to the DNA in the place where NF-KB would otherwise bind (a so-called “dominantly interfering molecule”); and 3) using a decoy molecule to bind to NF-KB itself.²⁹ Upon analysis of the specification, however, the patent application disclosed no working examples, let alone any prophetic examples, of methods of actually reducing NF-KB activity.³⁰

In sum, Ariad’s invention was the identification of NF-KB and its role in gene activation. Ariad hypothesized that if NF-KB activation is reduced, some toxic symptoms associated with known diseases could likewise be reduced. Ariad, however, did not actually invent a way of reducing NF-KB activation. Rather, Ariad hypothesized some probable ways to reduce NF-KB activation and attempted to obtain a broad patent claiming any possible method of suppressing NF-KB activation. The Federal Circuit found this was “little more than a research plan” and “an attempt to preempt the future before it has arrived.”³¹ Because the inventors did not describe any method of reducing NF-KB activation, their patent

²⁵ *Id.* at 1369–70.

²⁶ *Id.* at 1369.

²⁷ *Id.* at 1370.

²⁸ *Id.* at 1372.

²⁹ *Id.* at 1374–75.

³⁰ *Id.* at 1376.

³¹ *Id.* at 1373, 1376 (quoting *Fiers v. Revel*, 984 F.2d 1164, 1171 (Fed. Cir. 1993)).

was held invalid for failing to satisfy the written description requirement under § 112.³² The Federal Circuit did not reach the question of whether the patent fulfilled the enablement requirement because it held that, even if one skilled in the art was enabled to make the invention, “the scope of the right to exclude . . . does not overreach the scope of the inventor's contribution to the field of art as described in the patent specification.”³³ The court relied on the written description doctrine to ensure that the scope of the patent was commensurate with Ariad’s discovery and cautioned Ariad to be careful in what it asked for from the USPTO.³⁴

B. Brief Overview of the United States Patent System

Before tracing the case development of the written description requirement, this Section will briefly discuss some fundamental aspects of the United States patent system. The ultimate goal of the patent system is to bring new designs and technologies into the public domain through disclosure.³⁵ The exclusive rights granted by a patent are the carrots enticing inventors to make their invention known to the public. Before an inventor can obtain a patent, the USPTO must first examine the patent application to determine whether it satisfies the statutory requirements by “drawing a line between the things which are worth to the public the embarrassment of an exclusive patent, and those which are not.”³⁶ The core requirements of patent eligibility are that the invention must be useful, novel, and non-obvious.³⁷

Once the Patent Office has determined that the invention is useful, novel, and non-obvious, an inventor must still satisfy additional requirements. Several of these additional requirements

³² *Id.* at 1376–77.

³³ *Id.* at 1371 (quoting *Reiffin v. Microsoft Corp.*, 214 F.3d 1342, 1345–46 (Fed. Cir. 2000)).

³⁴ *See id.* at 1377 (“The motto, beware of what one asks for, might be applicable here.” (quoting *Liebel-Flarsheim Co. v. Medrad, Inc.*, 481 F.3d 1371, 1380 (Fed. Cir. 2007)) (internal quotation marks omitted)).

³⁵ *See Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 151 (1989) (quoting *United States v. Dubilier Condenser Corp.*, 289 U.S. 178, 186–87 (1933)).

³⁶ *Bonito Boats*, 489 U.S. at 148 (quoting 13 THOMAS JEFFERSON, WRITINGS OF THOMAS JEFFERSON 335 (Memorial ed. 1904)).

³⁷ *See* 35 U.S.C. §§ 101–03 (2006).

are located within 35 U.S.C. § 112, ¶ 1.³⁸ These relate to how detailed the inventor must be in his description of his own invention. The patent applicant must

describe his invention so that others may construct and use it after the expiration of the patent and [] inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.³⁹

Section 112, ¶ 1 has been construed to contain three requirements.⁴⁰ At issue for purposes of this Article are two of the three requirements, the enablement requirement and the written description requirement.⁴¹

The enablement requirement and the written description requirement, although commingled, are separate and distinct.⁴² The enablement requirement is satisfied when “the specification disclosure as a whole is such as to enable one skilled in the art to make and use the claimed invention”⁴³ This requirement forces the inventor to explain to the public how to make and use his invention. On the other hand, the function of the written description requirement “is broader than to merely explain how to ‘make and use’ [the invention]; the applicant must also convey with reasonable clarity to those skilled in the art, as of the filing date sought, that he or she was in possession of *the invention*.”⁴⁴ This requirement forces the inventor to describe his invention in sufficient detail that the public understands his invention and

³⁸ *Id.* § 112.

³⁹ *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U.S. 47, 57 (1938) (quoting *Permutit Co. v. Graver Corp.*, 284 U.S. 52, 60 (1931)) (internal quotation marks omitted).

⁴⁰ 35 U.S.C. § 112 (outlining a “written description” requirement, an enablement requirement, and a “best mode” requirement).

⁴¹ *See, e.g., In re Barker*, 559 F.2d 588, 591 (C.C.P.A. 1977).

⁴² *See id.* at 594 (Rich, J., concurring) (stating that the written description and enablement requirements are “distinct though commingled”).

⁴³ *In re Moore*, 439 F.2d 1232, 1235 (C.C.P.A. 1971).

⁴⁴ *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991); *see also In re Wertheim*, 541 F.2d 257, 262 (C.C.P.A. 1976) (“The function of the description requirement is to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him . . .”).

recognizes the inventor's contribution, and ensures that the inventor was truly in possession of the invention at the time he filed his patent application.

In summary, written description and enablement are part of the § 112 disclosure requirements.⁴⁵ These disclosure requirements ensure that the public gets a reciprocal benefit in exchange for granting the inventor the exclusive patent rights.⁴⁶

In exchange for all the detailed information about the invention, the patent office and the inventor work together to draft claims covering the scope of the new invention. Each sentence-long claim gives the inventor the exclusive right to stop others from making, using, or selling his invention within the United States.⁴⁷ It is these claims which define the outer bounds of the inventor's exclusive patent rights.⁴⁸

C. Historical Development of the Written Description Requirement

This Section will now trace the development of the written description requirement from the early Supreme Court cases, through the Court of Customs and Patent Appeals cases, through the early years at the Court of Appeals for the Federal Circuit.

1. Early Supreme Court: Reconciling Written Description with Claims

The first case applying a written description requirement is *Evans v. Eaton*.⁴⁹ In *Evans*, the Supreme Court found a "written description" requirement in the Patent Act of 1793⁵⁰ and invalidated the inventor's patent for failure to satisfy this requirement, even though his invention was sufficiently enabled.⁵¹ Thus, while the inventor explained how to make and use his invention, his written description of that invention was deemed

⁴⁵ 35 U.S.C. § 112.

⁴⁶ See *Merrill v. Yeomans*, 94 U.S. 568, 573–74 (1876).

⁴⁷ See 35 U.S.C. § 271.

⁴⁸ See *Johnson & Johnston Assocs. v. R.E. Serv. Co.*, 285 F.3d 1046, 1052 (Fed. Cir. 2002).

⁴⁹ 20 U.S. (7 Wheat.) 356 (1822).

⁵⁰ *Id.* at 433; see also Patent Act of 1793, Ch. 11, 1 Stat. 318 (1793).

⁵¹ *Evans*, 20 U.S. (7 Wheat.) at 434–35.

deficient. The purpose of the written description requirement, the Court explained, was to protect the public from the fear that an inventor may “pretend[] that his invention is more than what it really is.”⁵²

At the time of *Evans*, United States patent law did not require patents to have claims. Patent claims were first required with the Patent Act of 1836 and their use continues to this day.⁵³ A patent claim is a one-sentence description of an embodiment of the invention. While other parts of a patent application describe how to make and use the invention, the patent claims define the precise boundaries between what the inventor regards to be his invention and what he does not. Patent claims serve the public notice function of patent law by delineating the scope of the invention contained within the patent and defining the dividing line between infringing conduct and non-infringing conduct. When a patent applicant prosecutes a patent at the USPTO, the primary focus of the back-and-forth between the inventor and the USPTO regards the precise drafting of patent claims. A patent applicant files original claims and the USPTO, after searching the prior art, will often reject those claims as being too broad and capturing subject matter the patent applicant did not invent. At this point, the patent applicant can either submit new claims or amend the original claims to hew more closely to the line between his contribution and what had been done before. The written description requirement, separate and distinct from the enablement requirement, survived the invention of claims, as evidenced in *O’Reilly v. Morse*.⁵⁴

In *O’Reilly*, after Samuel Morse invented the telegraph, he attempted to claim the exclusive right not only to his own invention, but to all devices using electricity to print characters at a distance.⁵⁵ This was, in fact, the scope of claim 8 of his patent.⁵⁶ The Court held Morse’s claim 8 was “too broad, and not warranted

⁵² *Id.* at 434.

⁵³ *See* Patent Act of 1836, 5 Stat. 117.

⁵⁴ 56 U.S. (15 How.) 62, 113 (1854).

⁵⁵ *Id.* at 112–13.

⁵⁶ *Id.* at 111–12. Interestingly, this claim in his patent even survived a reissue at the USPTO. *Id.*

by law” because it was beyond the scope of his description.⁵⁷ Morse had claimed “an exclusive right to use a manner and process which he has not *described and indeed had not invented*, and therefore could not *describe* when he obtained his patent.”⁵⁸ Just as the inventor of the first steam engine was not entitled to a patent giving him the exclusive right to use steam as a motive power for the purpose of propelling vessels, the Court reasoned, Morse was not allowed to “shut[] the door against inventions of other persons” in this area where it was not within his invention description.⁵⁹ While the scope of Morse’s patent may have raised patentable subject matter concerns, it was nonetheless rejected for exceeding the scope of the invention described by Morse at the time of filing.⁶⁰

Following *Morse*, the Court continued to employ the written description requirement as a basis to invalidate patents and patent claims where the inventor had overreached beyond his true invention.⁶¹

During the period from the late 1800s through the early 1900s, it appears as though the Court was attempting to define the role of the written description requirement in light of the relatively recent addition of claims. Until this time, inventors were, perhaps intentionally, accustomed to using ambiguous terms to specify their inventions, and claims were added as an additional requirement to circumscribe the invention at its broadest.⁶² In both *McClain v. Ortmyer*⁶³ and *White v. Dunbar*,⁶⁴ for example, an alleged infringer’s invention did not fall within the scope of the patentee’s claims, yet the patentee sued, essentially arguing, “but this falls within what I said in my specification.” In response, the

⁵⁷ *Id.* at 113.

⁵⁸ *Id.* (emphasis added).

⁵⁹ *Id.* at 113.

⁶⁰ *Id.* at 119–20.

⁶¹ See *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U.S. 47, 56–57 (1938); *Permutit Co. v. Graver Corp.*, 284 U.S. 52, 55 (1931) (invalidating patent for an apparatus for softening water for lack of written description); *Merrill v. Yeomans*, 94 U.S. 568, 572 (1876) (invalidating claim to deodorized heavy oils for lack of written description).

⁶² *Merrill*, 94 U.S. at 573.

⁶³ 141 U.S. 419 (1891).

⁶⁴ 119 U.S. 47 (1886).

Court consistently reiterated the theme that “[t]he claim is the measure of [the patentee’s] right to relief, and while the specification may be referred to[,] to limit the claim, it can never be made available to expand it.”⁶⁵ Thus, at a time when the United States was among the first (if not the first) to require patent claims, the Court emphasized that these claims had a purpose—that of delimiting the “metes and bounds” of the invention so as to put the public on notice of the maximum scope of the patent⁶⁶—and made clear that the written description in the specification could not be relied upon to expand the patent scope beyond the claims.

2. Court of Customs and Patent Appeals: Adding Structure to § 112

The Court of Customs, initially formed in 1910, changed its name to the Court of Customs and Patent Appeals (“CCPA”) in 1929 and took on appeals from the United States Patent Office.⁶⁷ Regarding patent appeals, these took the form of either ex parte patent cases or inter partes interferences.⁶⁸ Prior to the creation of the CCPA, these appeals were handled by the Court of Appeals for the D.C. Circuit.⁶⁹ The Patent Act of 1952 enacted the current version of 35 U.S.C. § 112 containing the “written description” requirement, among others, within its first paragraph.⁷⁰

In the cases following the enactment of the Patent Act of 1952, the CCPA expressed frustration with the USPTO in many

⁶⁵ *McClain*, 141 U.S. at 424.

⁶⁶ *See id.*

⁶⁷ *Federal Judicial History: U.S. Court of Customs and Patent Appeals (Successor to the Court of Customs Appeals), 1910–1982*, FED. JUD. CTR., http://www.fjc.gov/history/home.nsf/page/courts_special_cpa.html [hereinafter *Federal Judicial History*] (last visited Oct. 21, 2010).

⁶⁸ Ex parte actions are those cases between the patent applicant and the U.S. Patent & Trademark Office concerning whether the applicant is entitled to a patent. Inter partes actions, on the other hand, are those cases between two patent applicants and the dispute is over which applicant is entitled to the patent—essentially, which applicant invented the invention first. *See Federal Judicial History*, *supra* note 67; *see also Board of Patent Appeals and Interferences*, U.S. PATENT & TRADEMARK OFFICE, <http://www.uspto.gov/ip/boards/bpai/index.jsp> (last visited Oct. 16, 2010).

⁶⁹ *See Federal Judicial History*, *supra* note 67.

⁷⁰ *See* 35 U.S.C. § 112 (2006).

opinions.⁷¹ This frustration stemmed from the USPTO's rejecting patents under § 112 without specifying the particular deficiency under § 112 and sometimes even mischaracterizing rejections under § 112.⁷²

The USPTO's confusion should come as little surprise when § 112 contains six paragraphs, and Judge Rich himself noted that several requirements exist within the first paragraph alone.⁷³ Judge Baldwin finally, in *In re Moore*,⁷⁴ took it upon himself to reduce confusion at the USPTO and "for the sake of completeness[,]” laid out the requirements under the first and second paragraphs of § 112.⁷⁵ Notably, Judge Baldwin expressed three requirements in the first paragraph of § 112: 1) the description of the invention, 2) enablement, and 3) best mode.⁷⁶

From this point on, the written description requirement continued to undergo case-by-case application and development.⁷⁷ The majority of the cases involving § 112 written description at the CCPA fell primarily into three categories: 1) interference proceedings, where two inventors essentially try to prove who was

⁷¹ See *In re Moore*, 439 F.2d 1232, 1235 (C.C.P.A. 1971) (expressing frustration with USPTO's imprecise rejection under § 112); *In re Robins*, 429 F.2d 452, 456 n.5 (C.C.P.A. 1970) (finding "the examiner's Answer to be singularly unclear as to the particular requirement or requirements of § 112 which were thought not to have been met"); *In re Borkowski*, 422 F.2d 904, 909 (C.C.P.A. 1970) (finding examiner took improper approach to § 112, second paragraph rejection because the claims were more properly rejected under § 112, first paragraph); *In re Ruschig*, 379 F.2d 990, 995-96 (C.C.P.A. 1967) (discussing examiner's unclear basis for rejecting claims based on § 112); *In re Gay*, 309 F.2d 769, 772 (C.C.P.A. 1962) (finding USPTO "confuse[d]" when best mode rejection was really an enablement rejection).

⁷² See *Moore*, 439 F.2d at 1232; *Robins*, 429 F.2d at 456 n.5; *Borkowski*, 422 F.2d at 909; *Ruschig*, 379 F.2d at 995-96; *Gay*, 309 F.2d at 772.

⁷³ *Gay*, 309 F.2d at 772 (noting that "two of the several requirements" exist in ¶ 1 alone).

⁷⁴ 439 F.2d at 1232.

⁷⁵ *Id.* at 1235.

⁷⁶ *Id.* at 1235-36.

⁷⁷ See *In re Rasmussen*, 650 F.2d 1212, 1214 (C.C.P.A. 1981) (finding § 112 is properly used to reject a claim amended to recite elements that lack support in the original disclosure); see also *In re Koller*, 613 F.2d 819, 825 (C.C.P.A. 1980) (reversing USPTO's rejection under § 102 on the grounds that applicant satisfied written description requirement of § 112); *In re Barker*, 559 F.2d 588, 593 (C.C.P.A. 1977) (purportedly resolving issue of whether "enablement" under § 112 is different from "written description" under § 112).

the first inventor;⁷⁸ 2) rejections during prosecution based upon anticipation where the applicant attempts to rely on an earlier filing to “swear behind” a cited reference;⁷⁹ and, 3) rejections during prosecution when later amendments were rejected for being unduly broad.⁸⁰

One of the more interesting cases during this time period is *In re Barker*.⁸¹ At issue in *Barker* was whether the “enablement” requirement is separate from the “written description” requirement.⁸² While this case purports to resolve the issue, the dividing lines quickly became apparent in this case, which generated a total of three opinions. This is perhaps the first case on record where the splintering of the court can be seen regarding the issue of written description. Judge Miller, writing for the court, traced the development of the written description doctrine through the patent acts starting with the Patent Act of 1790 up through the Patent Act of 1952.⁸³ Judge Miller ultimately concluded that the written description and enablement requirements are separate because “[t]hat a person skilled in the art might realize from reading the disclosure that such a step is possible is not a sufficient indication to that person that that step is part of [a patentee’s] invention.”⁸⁴ Judge Rich, agreeing with the result, would have resolved this case on application of § 132 and did not “subscribe to [the majority’s] interpretation through assumptions based on presumptions about the usage of superfluous words and the like.”⁸⁵ Judge Rich, of course, had previously found a separate written description requirement in *In re Ruschig*.⁸⁶ Chief Judge Markey dissented, arguing that the written description requirement “was

⁷⁸ See, e.g., *Fields v. Connover*, 443 F.2d 1386 (C.C.P.A. 1971) (considering which party had priority over a patent relating to a chemical compound).

⁷⁹ See, e.g., *Koller*, 613 F.2d at 821. An applicant “swears behind” a reference by providing proof, along with a sworn affidavit, that the applicant conceived his invention at a date prior to the date of the cited reference.

⁸⁰ See, e.g., *Rasmussen*, 650 F.2d at 1215.

⁸¹ 559 F.2d 588 (C.C.P.A. 1977).

⁸² See *id.* at 591.

⁸³ *Id.* at 592–93.

⁸⁴ *Id.* at 593 (quoting *In re Winkhaus*, 527 F.2d 637, 640 (C.C.P.A. 1975)).

⁸⁵ *Id.* at 594 (Rich, J., concurring) (noting that the new matter should be rejected solely on the basis of its violation of § 132).

⁸⁶ 379 F.2d 990, 995–96 (C.C.P.A. 1967).

solely a judicial (and unnecessary) response to chemical cases in which appellants were arguing that those skilled in the art ‘might’ make and use a claimed invention.’⁸⁷

The Court of Customs and Patent Appeals went a long way to help clarify the law used daily by the USPTO in examining patent applications. The court at various times recognized a written description requirement separate and apart from the enablement requirement.⁸⁸ However, while a majority of the court seemed to consider the issue resolved, the debate over the role of the written description requirement between Judge Miller, Judge Rich, and Chief Judge Markey in *In re Barker* foreshadowed the debate in *Ariad* more than thirty years later.⁸⁹

3. Early Court of Appeals for the Federal Circuit: How to Apply Precedent From USPTO Appeals at CCPA to Infringement Appeals from District Courts

In 1982, the Court of Appeals for the Federal Circuit was formed as a merger of the Court of Claims and the CCPA.⁹⁰ The Federal Circuit, in its first published opinion, adopted as binding precedent all the prior decisions of both the Court of Claims and the CCPA.⁹¹ The jurisdiction of the Federal Circuit was also expanded to include, among other things, appeals in patent cases from the district courts. Thus, for the first time, there would be a dedicated appellate court for hearing disputes between patentees and alleged infringers. Some scholars feared that the Federal Circuit would not benefit from the “percolation” that normally occurs in the regional circuits.⁹² The law in general and the

⁸⁷ *Barker*, 559 F.2d at 594 (Markey, J., dissenting).

⁸⁸ *See, e.g., id.* at 593 (Rich, J., concurring); *In re Smith*, 481 F.2d 910, 914 (C.C.P.A. 1973).

⁸⁹ *Compare Barker*, 559 F.2d at 593 with *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336 (Fed. Cir 2010) (en banc).

⁹⁰ Federal Courts Improvement Act, Pub. L. No. 97-164, 96 Stat. 25 (1982); *see also Federal Circuit Act of 1982*, FED. JUD. CTR., http://www.fjc.gov/history/home.nsf/page/landmark_22.html (last visited Aug. 27, 2010).

⁹¹ *South Corp. v. United States*, 690 F.2d 1368, 1370 (Fed. Cir. 1982).

⁹² *See, e.g.,* Ellen R. Jordan, *Specialized Courts: A Choice?*, 76 NW. U. L. REV. 745, 784 (1981) (noting that the efficiencies of a specialized patent court could “come at some cost, for better results may come from the ‘confluence of doctrines’” associated with courts of general jurisdiction hearing patent cases).

Supreme Court specifically, benefit from analyzing the varying approaches and rules of law among the regional circuits to decide which should prevail. Prior to the creation of the Federal Circuit, the predecessor court would only have had occasion to apply the written description requirement as a challenge to the validity of originally filed claims if the issue had already been raised by the USPTO in a rejection.⁹³ Now, alleged infringers could raise the issue of the failure to comply with the written description requirement of § 112 as an affirmative defense to patent infringement.⁹⁴

The written description doctrine at the Federal Circuit got off to a rocky start. In *Kennecott Corp. v. Kyocera Int'l Inc.*,⁹⁵ the court stated “[t]he purpose of the [written] description requirement . . . is to state what is needed to fulfil [sic] the enablement requirement.”⁹⁶ Notably, this is a position similar to the one Chief Judge Rader, and others, take today.⁹⁷ When read closely and in context, however, the case did not hold that a separate written description does not exist, but rather that “incorporation of the requirements of section 112 into section 120 ensures that the inventor had possession of [i.e., described] the later-claimed invention on the filing date of the earlier application.”⁹⁸ The court in *Vas-Cath Inc. v. Mahurkar*,⁹⁹ confirmed this aspect of the

⁹³ See, e.g., *In re Steinhauer*, 410 F.2d 411, 412 (C.C.P.A. 1969). This is because appeals from infringement suits at that time would have gone to the regional circuits. Similar to the Federal Circuit’s present trademark jurisdiction, the CCPA could only hear patent disputes between the patent applicant and the USPTO or priority disputes between two patent applications. In the latter situation, issues involving “original claims” are rarely at issue because in an interference proceeding, by definition, at least one applicant has amended their claim to be identical to those of the other, and thus trigger the interference.

⁹⁴ See, e.g., *Kennecott Corp. v. Kyocera Int'l Inc.*, 835 F.2d 1419, 1421 (Fed. Cir. 1987).

⁹⁵ 835 F.2d 1419 (Fed. Cir. 1987).

⁹⁶ *Id.* at 1421.

⁹⁷ See, e.g., *Univ. of Rochester v. G.D. Searle & Co., Inc.*, 375 F.3d 1303, 1310 (Fed. Cir. 2004) (Rader, J., dissenting); *id.* at 1305 (Linn, J., dissenting).

⁹⁸ *Kennecott*, 835 F.2d at 1421. 35 U.S.C. § 120 defines the requirements for when a later-filed patent application may claim priority over an earlier-filed application. See 35 U.S.C. § 120 (2006).

⁹⁹ 935 F.2d 1555 (Fed. Cir. 1991).

decision in *Kennecott* and sought to clear up any potential confusion.¹⁰⁰

In *Vas-Cath*, the USPTO rejected Mahurkar's attempt to claim priority back to the filing date of his previously filed design patent.¹⁰¹ Mahurkar filed a design patent depicting his invention in March of 1982.¹⁰² Subsequently, Mahurkar filed a utility patent in 1984 containing the same diagram of his invention that he included with his design patent in 1982.¹⁰³ *Vas-Cath* alleged that Mahurkar's patent, filed in 1984, was invalid because a Canadian patent issued in August of 1982, anticipated Mahurkar's patent.¹⁰⁴ Mahurkar claimed he was the first inventor and as proof, pointed to the filing of his design patent on March 1982, five months prior to the Canadian patent.¹⁰⁵ The district court held that the drawings in the previously filed design patent did not satisfy the written description requirement of § 112, which was required for Mahurkar to claim priority of invention under § 120.¹⁰⁶ The Federal Circuit reversed the district court's holding finding that drawings alone may satisfy the written description requirement of § 112.¹⁰⁷ Mahurkar was entitled to claim he possessed the invention at least as early as March 1982—before the Canadian patent issued—because his pictures adequately described his invention.¹⁰⁸

Most interesting about the *Vas-Cath* opinion was Judge Rich's review of the case law development of the written description requirement.¹⁰⁹ Particularly, Judge Rich noted "some confusion"

¹⁰⁰ *Id.* at 1563–64.

¹⁰¹ *Id.* at 1557. Because patentability often turns on who did something first, i.e., who has "priority" of invention, applicants often try to prove they were first. A patent applicant can claim priority back to an earlier-filed patent application, and hence be treated as though the newer application were filed on the earlier date, only if the requirements of 35 U.S.C. § 120 are satisfied. *See* 35 U.S.C. § 120; *see also supra* note 98.

¹⁰² *Vas-Cath*, 935 F.2d at 1557.

¹⁰³ *Id.* at 1558–59.

¹⁰⁴ *See id.* at 1558–59 (explaining that the Canadian patent asserted under § 102(b) was actually filed by Mahurkar shortly after he filed his U.S. design patent).

¹⁰⁵ *Id.* at 1559.

¹⁰⁶ *Id.* at 1557.

¹⁰⁷ *Id.* at 1565, 1567.

¹⁰⁸ *See id.*

¹⁰⁹ *See id.* at 1560–64.

as to whether the written description requirement is separate and distinct from the enablement requirement.¹¹⁰ To the extent *Kennecott* suggested written description and enablement are the same, Judge Rich simply disagreed and stated “we note that decisions of a three-judge panel of this court cannot overturn prior precedential decisions.”¹¹¹ In conclusion, the court reaffirmed the existence of a “written description requirement” in § 112 that is separate and distinct from the enablement requirement.¹¹²

4. Recent Court of Appeals for the Federal Circuit: Entrenchment and Percolation

The development of the written description doctrine has been complicated within the last ten years at the Federal Circuit. To be sure, not a single majority opinion ever held that the requirement simply did not exist.¹¹³ However, during this period, it became very clear how certain judges felt about the written description requirement. For example, *Union Oil Co. of California v. Atlantic Richfield Co.* (“*Unocal*”),¹¹⁴ foreshadowed the current dispute between Judge Lourie and Chief Judge Rader over the written description requirement. The patent at issue in *Unocal* was directed towards automobile gasoline compositions that reduce

¹¹⁰ *Id.* at 1563.

¹¹¹ *Id.* When the Federal Circuit was formed, it adopted as precedent all prior decisions by the CCPA. *See supra* note 91 and accompanying text. The Federal Circuit is therefore bound both by its prior precedential decisions and prior CCPA decisions. Further, the Federal Circuit can only overrule its own precedent (including binding CCPA decisions) by sitting en banc. *Vas-Cath*, 935 F.2d at 1563.

¹¹² *Id.*

¹¹³ *See In re Wilder*, 736 F.2d 1516, 1520 (Fed. Cir. 1984) (“The description requirement is found in 35 U.S.C. § 112 and is separate from the enablement requirement of that provision.”); *see also* *ICU Med., Inc. v. Alaris Med. Sys., Inc.*, 558 F.3d 1368, 1377–78 (Fed. Cir. 2009); *In re Alonso*, 545 F.3d 1015, 1019, 1021–22 (Fed. Cir. 2008); *Carnegie Mellon Univ. v. Hoffman-La Roche, Inc.*, 541 F.3d 1115, 1125–26 (Fed. Cir. 2008); *LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 424 F.3d 1336, 1344–45 (Fed. Cir. 2005); *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 921 (Fed. Cir. 2004); *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 968–69 (Fed. Cir. 2002); *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1478–80 (Fed. Cir. 1998); *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1566–69 (Fed. Cir. 1997); *Fiers v. Revel*, 984 F.2d 1164, 1171 (Fed. Cir. 1993).

¹¹⁴ 208 F.3d 989 (Fed. Cir. 2000) (affirming the validity of a patent claiming automotive gasoline compositions that reduce tailpipe emissions as against petroleum refiners).

tailpipe emissions.¹¹⁵ At issue was whether the patent, which described the invention in terms of ranges but otherwise failed to describe the exact chemical component of each combination falling within the disclosed ranges, satisfied the written description requirement.¹¹⁶ In *Unocal*, Chief Judge Rader wrote for the court affirming the validity of the patent-in-suit, on the grounds that it satisfied the written description requirement under § 112.¹¹⁷ Judge Lourie, in dissent, expressed his frustration that the majority was conflating written description and enablement.¹¹⁸

The debate over the written description requirement continued in *Enzo Biochem, Inc. v. Gen-Probe Inc.*¹¹⁹ In *Enzo*, the district court first invalidated Enzo's patent for failing to satisfy the written description requirement of § 112.¹²⁰ On appeal, the Federal Circuit affirmed the district court's finding of invalidity.¹²¹ Enzo then requested a rehearing (panel and en banc) on the issue of invalidity, and this time the Federal Circuit determined its prior decision on written description was incorrect.¹²² The court therefore vacated its prior panel decision, vacated the district court's grant of summary judgment finding the patent invalid for failure to satisfy the § 112 written description requirement, and denied the petition for en banc rehearing.¹²³ Several opinions were written for this case, and the positions of particular judges began to solidify.¹²⁴ The positions are discussed in detail in Part II below.

After *Enzo*, the views of certain judges became more pronounced. For example, *Moba, B.V. v. Diamond Automation, Inc.*,¹²⁵ is signed "per curiam." However, it is eerily reminiscent of Chief Judge Rader's view on written description, although it does

¹¹⁵ *Id.* at 991.

¹¹⁶ *See id.* at 997.

¹¹⁷ *Id.* at 1001.

¹¹⁸ *See id.* at 1002.

¹¹⁹ 323 F.3d 956 (Fed. Cir. 2002).

¹²⁰ *Enzo Biochem, Inc. v. Gen-Probe Inc.*, No. 99-4548, 2001 U.S. Dist. LEXIS 23791 at *2-3 (S.D.N.Y. Apr. 4, 2001).

¹²¹ *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 285 F.3d 1013, 1015 (Fed. Cir. 2002).

¹²² *Enzo*, 323 F.3d at 960.

¹²³ *Id.*

¹²⁴ *See id.* at 971 (Lourie, J., concurring); *id.* at 975 (Newman, J., concurring); *id.* (Dyk, J., concurring); *id.* at 976 (Rader, J., dissenting); *id.* at 987 (Linn, J., dissenting).

¹²⁵ 325 F.3d 1306 (Fed. Cir. 2003).

not go as far as his earlier pronouncements.¹²⁶ Chief Judge Rader also wrote a concurring opinion in *Moba* further expressing his view on written description, a position consistent with his earlier opinion in *Unocal* and his later opinion in *University of Rochester v. G.D. Searle & Co.*¹²⁷

In *Rochester*,¹²⁸ the viewpoints of particular judges became apparent once again. Judge Lourie wrote the panel opinion holding the University of Rochester's patent invalid for failure to comply with the written description requirement of § 112.¹²⁹ Judge Lourie's view on the law of written description was consistent with his earlier position taken in *Enzo* and *Unocal*.¹³⁰ The Federal Circuit later denied Rochester's petition for en banc rehearing, resulting in five separate judicial opinions.¹³¹

The confusion surrounding the role of the written description requirement finally came to a head in the first *Ariad* decision. In *Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co.*,¹³² Judge Moore, writing for the majority, found Ariad's patent invalid for failure to comply with the written description requirement.¹³³ Judge Linn wrote a concurrence, finding the written description aspect of the decision supported by precedent, but expressing his view that a separate written description requirement is misguided.¹³⁴ The court finally decided it was time to resolve the conflicts surrounding the written description requirement and granted

¹²⁶ See *id.* at 1309, 1319–20 (describing two applications of written description case law, one consistent with 1967 precedent as priority policing, and one new creation in 1997 with the criticized *Lilly* opinion).

¹²⁷ Compare *Moba*, 325 F.3d at 1323, with *Univ. of Rochester v. G.D. Searle & Co.*, 375 F.3d at 1303, 1320 (Fed. Cir. 2004), and *Union Oil Co. of Cal. v. Atl. Richfield Co.*, 208 F.3d 989, 997 (Fed. Cir. 2000).

¹²⁸ 358 F.3d 916 (Fed. Cir. 2004), *en banc reh'g denied*, 375 F.3d 1303.

¹²⁹ *Id.* at 917.

¹³⁰ Compare *Rochester*, 375 F.3d at 1305 with *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 960 (Fed. Cir. 2002), and *Unocal*, 208 F.3d at 1002.

¹³¹ See *Rochester*, 375 F.3d at 1304 (Newman, J., dissenting); *id.* at 1305 (Lourie, J., concurring); *id.* at 1307 (Rader, J., dissenting); *id.* at 1325 (Linn, J., dissenting); *id.* at 1327 (Dyk, J., concurring).

¹³² *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 560 F.3d 1366 (Fed. Cir. 2009), *aff'd en banc*, 598 F.3d 1336 (Fed. Cir. 2010).

¹³³ *Id.* at 1380.

¹³⁴ *Id.* at 1380–81 (Linn, J., concurring).

Ariad's petition for en banc rehearing on the issue of written description.¹³⁵

Analyzing the case law development of the written description requirement during this period at the Federal Circuit is extremely difficult. Many contradictory opinions (whether concurring or dissenting) were written regarding the scope and application of the written description requirement. Binding precedent established a separate written description requirement and its scope, but many judges were beginning to question the wisdom of that precedent. By this time, the three main camps had settled upon their body of case law for string quotes and propositions that favored their positions, while dismissing others away as dicta or not entirely accurate.¹³⁶ "The differences of opinion among the judges of the Federal Circuit, are, in microcosm, the 'percolation' that scholars feared would be lost by a national court at the circuit level."¹³⁷ This splintering of the Federal Circuit into three main camps regarding the role of the written description requirement is therefore not bad at all. On the contrary, this creative tension serves to benefit patent law and is precisely the reason the Federal Circuit has succeeded despite its unique structure in the federal court system. However, in granting Ariad's petition for rehearing en banc, the court seems to have decided that the question of a separate written description requirement "ha[d] percolated enough" and was "ripe for en banc resolution."¹³⁸

II. THREE MAIN CAMPS IN THE FEDERAL CIRCUIT

In researching the written description debate at the Federal Circuit, three voices stand out time and again: Chief Judge Rader's, Judge Lourie's, and Judge Linn's. The Federal Circuit is highly respected for its well rounded and esteemed bench, and these three are certainly no exception. Indeed, among this group of

¹³⁵ Ariad Pharm., Inc. v. Eli Lilly & Co., 595 F.3d 1329, 1330 (Fed. Cir. 2009) (granting the petition for rehearing en banc).

¹³⁶ See *supra* note 131 (highlighting differing opinions among Federal Circuit judges on the written description requirement).

¹³⁷ Univ. of Rochester v. G.D. Searle & Co., 375 F.3d 1303, 1305 (Fed. Cir. 2004) (Newman, J., dissenting).

¹³⁸ *Id.*

three judges are the current Chief Judge of the Federal Circuit, three Jefferson Medal Recipients, and two former patent practitioners.¹³⁹

A. *Judge Lourie: Written Description Has Protected The Quid Pro Quo Since 1793*

Judge Lourie's position is perhaps the simplest to explain and is articulated in his majority opinions in *Rochester* and *Enzo*.¹⁴⁰ His opinions and rationale governed every majority panel of the Federal Circuit since 1992.¹⁴¹ Essentially, Judge Lourie's view is that the written description requirement exists and always has existed in patent law.¹⁴² "The purpose of the 'written description' requirement is broader than to merely explain how to 'make and use' the invention; rather, the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention."¹⁴³ The written description requirement, according to Judge Lourie, "is satisfied by the patentee's disclosure of such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention."¹⁴⁴

This construction of the written description requirement does not conflict with the role of patent claims, according to Judge Lourie.¹⁴⁵ While the claims certainly define the right of the patentee to exclude others from practicing the invention, it is the written description that teaches the invention.¹⁴⁶ An inventor is entitled to claims as broad as the invention which he has actually discovered. Thus, while the claims must be supported by the

¹³⁹ See *Judges*, U.S. COURT OF APPEALS FOR THE FED. CIR., http://www.ca9.uscourts.gov/index.php?option=com_content&view=article&id=132&Itemid=24 (follow "Richard Linn, Circuit Judge" hyperlink and "Alan D. Lourie, Circuit Judge" hyperlink) (last visited Aug. 27, 2010).

¹⁴⁰ *Rochester*, 375 F.3d at 1305 (Lourie, J., concurring); *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 971 (Fed. Cir. 2002) (Lourie, J., concurring).

¹⁴¹ See *supra* notes 113–24 and accompanying text.

¹⁴² *Rochester*, 375 F.3d at 1305.

¹⁴³ *Enzo*, 323 F.3d at 969 (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991)).

¹⁴⁴ *Id.*

¹⁴⁵ *Id.* (quoting *Lockwood v. Am. Airlines*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) (internal quotation marks omitted)).

¹⁴⁶ See *Rochester*, 375 F.3d at 1306 (Lourie, J., concurring).

written description, the written description contains a lot of extra material that is not in the claims, but rather, is necessary to teach the invention and to explain precisely what constitutes the invention.¹⁴⁷

Judge Lourie's view, and indeed the court's view, of the written description requirement is necessarily more demanding than the views of Chief Judge Rader or Judge Linn. This is so because in addition to the "enablement" requirement, which Judges Rader and Linn agree exists, Judge Lourie finds that a patentee must also meet the demands of a separate "written description" requirement, also contained in § 112.¹⁴⁸ In Judge Lourie's view, written description requires that inventors not only explain how to make and use the invention (i.e., "enable" the invention), but also explain in sufficient detail to one of skill in the art what it is that the inventor claims to have invented (i.e., "describe" the invention) and demonstrate that he had "possession" of the invention at the time of filing.¹⁴⁹

B. Chief Judge Rader: Judge Lourie's Written Description is Dead, New Written Description as Priority Policeman

Chief Judge Rader, on the other hand, views written description quite differently. His view is also best illustrated by his dissents in *Rochester* and *Enzo*. According to Chief Judge Rader, the written description doctrine that Judge Lourie traces back to the Patent Act of 1793 was actually superseded by the introduction of patent claims in the Patent Act of 1836.¹⁵⁰ The only "written description" requirement, according to Chief Judge Rader, is the new "judge-made doctrine" created in 1967 by Judge Rich in *In re Ruschig*.¹⁵¹

This new written description requirement was created only to prevent a patent applicant from adding new matter to his claims

¹⁴⁷ *Id.*

¹⁴⁸ *Id.*

¹⁴⁹ *Id.*

¹⁵⁰ See *Enzo*, 323 F.3d at 977 (Rader, J., dissenting) ("In later enactments [of the Patent Act], this notice function was assigned to claims, leaving enablement as the only purpose of the 'written description' language.").

¹⁵¹ See *id.* at 977-78 (citing *In re Ruschig*, 379 F.2d 990 (C.C.P.A. 1967)).

that were not contained in his original application.¹⁵² For example, consider a patent applicant who files a patent in 2001 covering a process of making freeze-dried instant coffee where concentrated coffee extract is freeze-dried when it contains solids between 25% and 60%.¹⁵³ The patent applicant would not be able to amend his application in 2002 to include the process of making freeze-dried coffee where the solid content in the concentrated coffee extract is “greater than 35%.” Nor is the patent applicant entitled to later claim the range from 35% to 100% as his invention because he did not describe his invention as covering that range when he filed his patent application in 2001.¹⁵⁴ Rather, when the inventor first discovered his invention in 2001, he described his invention as covering only the range from 25% to 60%. The written description requirement therefore serves one function: “to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter *later* claimed by him.”¹⁵⁵

According to Chief Judge Rader, the Federal Circuit first made the mistake of applying the written description requirement as a general disclosure doctrine in place of enablement in the 1997 case of *Regents of the University of California v. Eli Lilly and Co.*¹⁵⁶ In *Lilly*, the patent specification at issue disclosed a general method of producing human insulin cDNA and contained a description of rat insulin cDNA, but did not provide a written description of human insulin cDNA.¹⁵⁷ The court held that “[d]escribing a method of preparing a cDNA or even describing the protein that the cDNA encodes, as the example [in the specification] does, does not necessarily describe the cDNA itself.”¹⁵⁸ Accordingly, the court concluded, “a description of rat insulin cDNA is not a description of the broad classes of vertebrate or mammalian insulin

¹⁵² *See id.* at 978.

¹⁵³ This example is loosely based upon the facts of *In re Wertheim*, 541 F.2d 257 (C.C.P.A. 1976).

¹⁵⁴ *Id.*

¹⁵⁵ *Univ. of Rochester v. G.D. Searle & Co.*, 375 F.3d 1303, 1311 (Fed. Cir. 2004) (Rader, J., dissenting) (citing *Wertheim*, 541 F.2d at 262).

¹⁵⁶ *See Enzo*, 323 F.3d at 988 (citing *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559 (Fed. Cir. 1997)).

¹⁵⁷ *See Lilly*, 119 F.3d at 1567.

¹⁵⁸ *Id.*

cDNA,” including human cDNA.¹⁵⁹ Chief Judge Rader would have invalidated the patent for failure to satisfy the enablement requirement instead, because “the inventor certainly did not show one of skill in the art how to make human insulin cDNA.”¹⁶⁰ By invalidating the patent on the grounds of failure to satisfy the written description requirement, the Chief Judge argued, the Federal Circuit “purported to create a new doctrine for adequacy of disclosure that it labeled incorrectly ‘written description’ . . . [which] had never been a free-standing substitute for enablement.”¹⁶¹

Chief Judge Rader’s position can be summed up by stating that written description is only properly used as a way to police priority of invention. It ensures that an inventor does not file a patent application in Year 1, then later, in Year 3 try to claim his invention in Year 1 was broader than it really was. In Chief Judge Rader’s view, the court’s “written description” requirement should not try to replace the existing enablement requirement, which has worked just fine.

C. Judge Linn: There is No Written Description

Judge Linn’s position on written description is expressed in *Ariad*, *Rochester*, and *Enzo*. Judge Linn is of the opinion that there is no separate written description requirement.¹⁶² Section 112 “requires no more of the specification than a disclosure that is sufficient to enable a person having ordinary skill in the art to make and use the invention.”¹⁶³ The written description “requirement” is satisfied by the enablement requirement; therefore, a separate written description requirement does not exist.¹⁶⁴ In Judge Linn’s view, the claims determine the scope of the invention and the creation of a separate written description

¹⁵⁹ *Id.* at 1568.

¹⁶⁰ *Enzo*, 323 F.3d at 980 (Rader, J., dissenting).

¹⁶¹ *Id.*

¹⁶² *See Ariad Pharm., Inc., v. Eli Lilly & Co.*, 560 F.3d 1366, 1380–81 (Fed. Cir. 2009) (Linn, J., concurring), *aff’d en banc*, 598 F.3d 1336 (Fed. Cir. 2010).

¹⁶³ *Id.*

¹⁶⁴ *See id.* at 1381.

requirement confuses the public as to where they should look to determine the scope of the patent.¹⁶⁵

Judge Linn's position is, in part, consistent with Chief Judge Rader's opinion.¹⁶⁶ While both believe that the need for a separate written description requirement was eliminated with the advent of patent claims, Judge Linn does not share Chief Judge Rader's belief that a new "written description" requirement was created in 1967.¹⁶⁷ Thus, Judge Linn believes that once a patent is issued, the only inquiry into the specification should be for purposes of determining compliance with the enablement requirement.¹⁶⁸

III. ANALYSIS

A. Purpose of Written Description Requirement

The purpose of the written description requirement stems from the social contract notion of patent law. Before an inventor can secure the monopoly rights to exclude others from the practice of his invention, the inventor must make an adequate public disclosure of that invention.¹⁶⁹ This concept is at the heart of our patent system.¹⁷⁰

The written description requirement serves to ensure that, in exchange for granting a patent, the public gets the full disclosure of the invention so that it may possess the entire invention when that patent expires.¹⁷¹ In *Merrill v. Yeomans*,¹⁷² the Court held a patent invalid for failure to comply with the written description requirement because the application was "far from possessing that

¹⁶⁵ See *id.*

¹⁶⁶ Compare *Enzo*, 323 F.3d at 977–78 (Rader, J., dissenting) (asserting that "the only purpose of the 'written description' language" in "later enactments" of the Patent Act is "enablement"), with *Ariad*, 560 F.3d at 1380–81 (Linn, J., concurring) (asserting that the purpose of a "written description of the invention" is enablement).

¹⁶⁷ See *id.* (noting that because claims are the true measure of the scope of a patent, a written description inquiry confuses the matter); see also *Univ. of Rochester v. G.D. Searle & Co.*, 375 F.3d 1303, 1325 (Fed. Cir. 2004).

¹⁶⁸ See *Ariad*, 560 F.3d at 1380–81.

¹⁶⁹ *Merrill v. Yeomans*, 94 U.S. 568, 570 (1876).

¹⁷⁰ The patent system was created to satisfy the constitutional instruction "[t]o promote the Progress of Science and useful Arts." See U.S. CONST. art. I, § 8.

¹⁷¹ See *id.*

¹⁷² 94 U.S. 568 (1876).

precision and clearness of statement with which one who proposes to secure a monopoly at the expense of the public ought to describe the thing which no one but himself can use or enjoy, without paying him for the privilege of doing so.”¹⁷³ In further elaborating on this *quid pro quo*, the Court stated:

The growth of the patent system in the last quarter of a century in this country has reached a stage in its progress where the variety and magnitude of the interests involved require accuracy, precision, and care in the preparation of all the papers on which the patent is founded. . . . The developed and improved condition of the patent law, and of the principles which govern the exclusive rights conferred by it, leave no excuse for ambiguous language or vague descriptions. The public should not be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights. The genius of the inventor, constantly making improvements in existing patents,—a process which gives to the patent system its greatest value,—should not be restrained by vague and indefinite descriptions of claims in existing patents from the salutary and necessary right of improving on that which has already been invented. It seems to us that nothing can be more just and fair, both to the patentee and to the public, than that the former should understand, and correctly describe, just what he has invented, and for what he claims a patent.¹⁷⁴

This public notice function of the written description requirement serves “to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.”¹⁷⁵ Thus, while the public can look to the claim of a patent, a one-sentence declaration of the scope of the invention, the inventor is only entitled to claims consistent in

¹⁷³ *Id.*

¹⁷⁴ *Id.* at 573–74.

¹⁷⁵ *Permutit Co. v. Graver Corp.*, 284 U.S. 52, 60 (1931).

scope and magnitude with the actual invention.¹⁷⁶ The CCPA, in *In re Sus*,¹⁷⁷ recognized “[t]he public purpose on which the patent law rests requires the granting of claims commensurate in scope with the invention disclosed.”¹⁷⁸ In other words, “the invention claimed shall be no broader than the invention set forth in the written description forming part of the specification.”¹⁷⁹

Judge Rich, in *Fields v. Conover*,¹⁸⁰ commented on the policy grounds of written description.¹⁸¹ The patents at issue in *Fields* related to chemical compositions having antibacterial agents.¹⁸² The dispute turned on whether Conover’s specification provided written description support for a specific compound when nowhere in the 196 pages of his specification was a single compound named or identified by formula. Judge Rich’s discussion hints at the problem of a loose written description requirement, namely, that inventors will overreach, thus deterring legitimate future innovation:

Here, Conover is concededly first with an extremely broad discovery, broad claims have already been allowed, and broad, non-elected claims roughly corresponding to Formula XXII are pending which, if allowed, will dominate most, if not all, the scope of Fields’ claims. If Conover is allowed to copy Fields’ claims merely because the application is sufficient to teach how to make and use the subject matter thereof and points indistinctly and ambiguously in the general direction of that subject matter, the socially valuable incentive to further research and development provided by the opportunity to obtain subservient patents will be considerably diminished.¹⁸³

¹⁷⁶ See *In re Sus*, 306 F.2d 494, 505 (C.C.P.A. 1962).

¹⁷⁷ 306 F.2d 494, 505 (C.C.P.A. 1962).

¹⁷⁸ *Id.* at 497.

¹⁷⁹ *Id.*

¹⁸⁰ 443 F.2d 1386 (C.C.P.A. 1971).

¹⁸¹ *Id.* at 1392.

¹⁸² *Id.* at 1387.

¹⁸³ *Id.*

This problem came full circle in *Fiers v. Revel*,¹⁸⁴ a case involving original claims. In *Fiers*, the Federal Circuit affirmed a denial of priority to an earlier-filed application because it did not provide adequate written description support under § 112.¹⁸⁵ The court, in finding a lack of written description support, found Revel's disclosure to represent merely "a wish, or arguably a plan, for obtaining the DNA."¹⁸⁶ The court explained that a "bare reference to a DNA with a statement that it can be obtained by reverse transcription is not a description; it does not indicate that Revel was in possession of the DNA."¹⁸⁷ Rather, "Revel's application does not even demonstrate that the disclosed method actually leads to the DNA, and thus that he had possession of the invention, since it only discloses a clone that might be used to obtain *mRNA* coding for B-IF."¹⁸⁸

The purpose of the written description requirement under § 112 is, and always has been, to prevent inventors from overreaching when securing a patent from the public. "[I]t is broader than to merely explain how to 'make and use;' the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*," the invention being "*whatever is now claimed*."¹⁸⁹ Further, "the invention" is defined by the claims on appeal, regardless of whether they are original claims or later-amended claims.¹⁹⁰

The written description requirement limits the inventor to that which he actually invented and disclosed in his original filing with the patent office—no more, no less.¹⁹¹ In order for the inventor to be "entitled" to a particular filing date, he must fully disclose his

¹⁸⁴ 984 F.2d 1164, 1166, 1169 (Fed. Cir. 1993).

¹⁸⁵ *Id.*

¹⁸⁶ *Id.* at 1171.

¹⁸⁷ *Id.*

¹⁸⁸ *Id.*

¹⁸⁹ *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991).

¹⁹⁰ *See id.* at 1565.

¹⁹¹ *O'Reilly v. Morse*, 56 U.S. (15 How.) 62, 135 (1854) (Grier, J., dissenting); *see also supra* notes 98, 101 for a discussion of "swearing behind" and priority.

invention at the time of filing.¹⁹² Whether the inventor attempts to broaden his claims through amendment,¹⁹³ to swear behind a § 112 reference by claiming priority to an earlier-filed application,¹⁹⁴ or to defend a broad charge in an interference,¹⁹⁵ written description ensures that the inventor only gets rights to exclude commensurate in scope with that which he has actually invented.¹⁹⁶ This is not to say the claims do not have a function; certainly they are the outer bounds of the scope of the patent.¹⁹⁷ However, an inventor must first satisfy the written description requirement before he is entitled to claims of any breadth.

Chief Judge Rader's reading of the written description requirement—i.e., that it only functions to police priority to later-filed claims—is too constricted.¹⁹⁸ Whether an inventor is trying to swear behind a reference or obtain a patent with claims as originally filed, the policies of patent law require that he tell the public what he has invented.¹⁹⁹ The written description requirement, as envisioned by Judge Lourie and consistent with nearly two hundred years of precedent serves to police priority *even in original applications* at the USPTO. In order to establish entitlement to a particular filing date, the inventor must be able to describe, among other things, what it is that he has invented. In other words, he must demonstrate that he is in “possession” of the

¹⁹² *Id.* at 126–27 (Grier, J. dissenting) (holding a patent invalid for lack of written description when the inventor could not describe the process and did not actually invent it).

¹⁹³ *See, e.g., In re Lew*, 257 Fed. App'x 281, 285 (2007) (stating that an amendment is not inherent to the original specification for the purposes of § 112 if it would broaden the scope of the invention beyond the initial disclosure).

¹⁹⁴ *See, e.g., Vas-Cath*, 935 F.2d at 1555.

¹⁹⁵ *See, e.g., In re Baxter*, 656 F.2d 679, 682 (C.C.P.A. 1981).

¹⁹⁶ *See Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1353–54 (Fed. Cir. 2010) (en banc).

¹⁹⁷ *McClain v. Ortmyer*, 141 U.S. 419, 424 (1891) (“The claim is the measure of [the patentee's] right to relief, and while the specification may be referred to[,] to limit the claim, it can never be made available to expand it.”).

¹⁹⁸ *See Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 981 (Fed. Cir. 2002) (Rader, J., dissenting).

¹⁹⁹ *See McClain*, 141 U.S. 419 at 423–24 (“Nothing is better settled in the law of patents than that the patentee may claim the whole or only a part of his invention, and that if he only *describe and claim* a part, he is presumed to have abandoned the residue to the public.” (emphasis added)).

claimed invention. Written description is the “show me, don’t tell me” requirement of patent law.

B. Common Misconceptions and Mischaracterizations of the Written Description Requirement

1. Statutory Construction Supports Three Requirements in § 112, ¶ 1.

Chief Judge Rader suggests in *Enzo* that a separate written description requirement in 35 U.S.C. § 112, ¶ 1 disregards the clear mandate of the statute.²⁰⁰ Section 112, ¶ 1 provides:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.²⁰¹

Upon inspection, it is apparent that there are two “, and”s in this section, effectively dividing this paragraph into three parts:

[Construction 1:]

The specification shall contain a written description
[1] of the invention, and
[2] of the manner and process of making and using it,
in such full, clear, concise, and exact terms
as to enable any person skilled in the art
to which it pertains, or
with which it is most nearly connected,
to make and use the same, and
[3] shall set forth the best mode contemplated by
the inventor of carrying out his invention.²⁰²

²⁰⁰ *Enzo*, 323 F.3d at 976 (Rader, J., dissenting).

²⁰¹ 35 U.S.C. § 112, ¶ 1 (2006).

²⁰² *Id.*

Some suggest the division above is improper, and that a proper construction contains only two requirements:

[Construction 2:]

[1] The specification shall contain a written description of the invention, *and* of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and

[2] shall set forth the best mode contemplated by the inventor of carrying out his invention.²⁰³

Dividing § 112, ¶ 1 into two sections, however, as in Construction 2 above, ignores the “, and” in part [1] (emphasized above). “As a principle of statutory construction, it is presumed that Congress [does] not use superfluous words.”²⁰⁴ By contrast, splitting § 112, ¶ 1 into three separate and distinct requirements makes contextual sense, remains consistent with the plain language of the statute, and does not require the use of superfluous words. Indeed, Judge Rich, who was influential in the enactment of the Patent Act of 1952, declared that the written description language was “preserved, in writing the Patent Act of 1952, because [it was] familiar and had many times been construed.”²⁰⁵ Had Congress intended to remove the separate written description requirement, or to combine it with the enablement requirement, it could have removed the clause “and of the manner and process of making, constructing, using, and compounding the same,”²⁰⁶ but it did not.²⁰⁷ As Judge Rich stated, Congress intended to preserve the written description requirement as it was.²⁰⁸

Thus, while Chief Judge Rader chastised the *Enzo* majority for disregarding the text of § 112, saying “[i]f it is possible to characterize disregard of statutory text as a secondary mistake, this

²⁰³ *Id.* (emphasis added).

²⁰⁴ *In re Barker*, 559 F.2d 588, 591–92 (C.C.P.A. 1977).

²⁰⁵ *Id.* at 594 (Rich, J., concurring).

²⁰⁶ Patent Act of 1836, ch. 357, § 6, 5 Stat. 117, 119.

²⁰⁷ *See Barker*, 559 F.2d at 591–92.

²⁰⁸ *Id.* at 594 (Rich, J., concurring).

case fits that classification,”²⁰⁹ his approach is, in fact, less faithful to the statute.²¹⁰

2. The Written Description Requirement Survived the Introduction of Patent Claims.

Chief Judge Rader suggests that the “written description” requirement originated with the Patent Act of 1793 but was quickly replaced by claims with the passage of the Patent Act of 1836.²¹¹ On this theory, written description was collapsed into enablement from 1836 until 1967 when Judge Rich “created” a new written description doctrine to enforce priority.²¹² However, Chief Judge Rader has little case support for this proposition and does not address any of the cases decided between 1836 and 1967 which viewed written description as separate from enablement.²¹³

In *Enzo*, Judge Lourie offered perhaps the strongest response to Chief Judge Rader’s position. While it may be correct that written description historically served a critical purpose before claims were required, he argued, the statute was never amended to delete the written description requirement once claims were introduced.²¹⁴ In fact, language similar to today’s “written description” requirement in § 112, can be traced all the way back to each and every Patent Act since 1793 and remains “virtually unchanged.”²¹⁵ Chief Judge Rader cites *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*²¹⁶ for the proposition that “[t]he responsibility for changing settled law rests with Congress. . . . Fundamental alterations in these rules risk destroying the legitimate expectations of inventors in their property.”²¹⁷

²⁰⁹ *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 976 (Fed. Cir. 2002) (Rader, J., dissenting).

²¹⁰ *See Moba v. Diamond Automation, Inc.*, 325 F.3d 1306, 1327–28 (Bryson, J., concurring) (“[I]f the *Ruschig* line of cases is sound as a matter of statutory construction, it is difficult to see why that construction does not apply equally in the *Lilly* non-priority context.”).

²¹¹ *See Enzo*, 323 F.3d at 977 (Rader, J., dissenting).

²¹² *See id.* at 977–78.

²¹³ *Id.*

²¹⁴ *Id.* at 971 (Lourie, J., concurring).

²¹⁵ *See Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 922 (Fed. Cir. 2004).

²¹⁶ 535 U.S. 722 (2002).

²¹⁷ *Enzo*, 323 F.3d at 982 (quoting *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 739 (2002)).

However, in reading the written description requirement out of § 112, Chief Judge Rader was himself ignoring the intent of Congress and inviting the concomitant risks. Moreover, as the Supreme Court has explained, “repeals by implication are not favored. . . . [T]he intention of [Congress] to repeal must be clear and manifest.”²¹⁸ Thus, if Congress intended to repeal the written description requirement, it is reasonable to assume it would have excised it from the statute itself.

Further, cases immediately following the creation of claims continued to rely on the written description requirement to invalidate patents. In fact, Chief Judge Rader’s assertion that written description, as known pre-1836, disappeared until a new version resurfaced in 1967 completely ignores 131 years of precedent.²¹⁹ The construction of § 112 that requires portions of it to apply only to police priority while other portions, within the same sentence, to apply at all times is simply untenable.

3. Judge Rich did not “Reinvent” Written Description with *In re Ruschig*

Chief Judge Rader continues to express his view that Judge Rich created a new “judge-made doctrine” of written description in

²¹⁸ *Tenn. Valley Auth. v. Hill*, 437 U.S. 153, 189–90 (1978) (quoting *Posadas v. Nat’l City Bank*, 296 U.S. 497, 503 (1936)).

²¹⁹ *See, e.g., Diamond v. Chakrabarty*, 447 U.S. 303, 312 (1980) (discussing how the Plant Patent Act of 1930 was enacted in part to overcome an obstacle to plant patents regarding their ability to satisfy the written description requirement); *Schriber-Schroth v. Cleveland Trust*, 305 U.S. 47, 61 (1938) (invalidating patent to “laterally flexible web” in piston design for an internal combustion engine for lack of written description support); *R.R. Co. v. Mellon*, 104 U.S. 112, 117–18 (1881) (observing that the Patent Act of 1836 has a written description requirement to make a patent valid as well as an enablement requirement); *Merrill v. Yeomans*, 94 U.S. 568, 573–74 (1876) (invalidating infringement claim to deodorized heavy oils for lack of written description); *O’Reilly v. Morse*, 56 U.S. (15 How.) 62, 120–21 (1854) (invalidating a claim of Samuel Morse for failure to satisfy the written description requirement); *Jepson v. Coleman*, 314 F.2d 533 (C.C.P.A. 1963) (denying priority to inventor in interference when parent application did not satisfy written description requirement despite providing an enabling disclosure); *In re Gay*, 309 F.2d 769, 772 (C.C.P.A. 1962) (stating that “two of the several” requirements of § 112 include enablement and best mode which implies that something else must remain); *In re Sus*, 306 F.2d 494, 495–96 (C.C.P.A. 1962) (invalidating patent claims for being “unduly broad,” or beyond the scope of the invention described in the “written description”); *In re Moore*, 155 F.2d 379, 382 (C.C.P.A. 1946) (invalidating claims for being broader than written description).

1967 in *In re Ruschig*.²²⁰ In making this broad pronouncement, Chief Judge Rader overlooks many of the earlier decisions applying the written description requirement between 1836 and 1967 from both the Supreme Court and the CCPA.²²¹ In Chief Judge Rader's defense, he has clearly pinpointed one function and application of the written description requirement—namely, that of preventing inventors from writing a broad specification, then later, in response to an interference or to swear behind a reference, attempting to claim something broader than originally invented. Chief Judge Rader cannot, however, point to any support for the proposition that the written description requirement under § 112 is only to be applied in those limited situations. As Judge Bryson pointed out in his concurrence in *Moba*, “[t]here is no language in section 112 that would support such a restriction.”²²²

For example, consider *In re DiLeone*.²²³ The sole issue in this case was “whether the specification satisfie[d] the [written] description requirement of the first paragraph of 35 U.S.C. § 112.”²²⁴ The panel, including Judge Rich, reiterated that the written description requirement is separate and distinct from enablement.²²⁵ In fact, the court recognized that the written description requirement need not rise and fall with the enablement requirement.²²⁶ The court certainly did not say, “this only applies to police priority.” Although the court “note[d] that the expression in question appeared in the originally filed claims,” the court did not rely solely on that fact to resolve the matter.²²⁷ Rather, the CCPA performed the requisite fact-based analysis and determined

²²⁰ See *Rochester*, 375 F.3d at 1311 (Rader, J., dissenting) (“Judge Rich, the first judge to use the description requirement to police priority”); *Moba B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319 (Fed. Cir. 2003) (per curiam) (“[CCPA] inaugurated use of § 112 to prevent the addition of new matter to claims.”); *Id.* at 1323–24 (Rader, J., concurring) (“In *In re Ruschig*, this court’s predecessor court created a new written description requirement for the sole purpose of enforcing priority issues.”); *Enzo*, 323 F.3d at 977–78 (Rader, J., dissenting) (“[CCPA] created for the first time a new WD doctrine to enforce priority.”).

²²¹ See *Federal Circuit Act of 1982*, *supra* note 90.

²²² *Moba*, 325 F.3d at 1327 (Bryson, J., concurring).

²²³ 436 F.2d 1404 (C.C.P.A. 1971).

²²⁴ *Id.* at 1405.

²²⁵ *Id.*

²²⁶ *Id.*

²²⁷ *Id.* at 1406.

the specification was at least as broad as the applicant's broadest claims.²²⁸ If Chief Judge Rader's view of the law is correct, the court would have simply stopped once it realized the expression in question was in the originally filed claims.

Similarly, in *In re Moore*,²²⁹ the CCPA, analyzing § 112, explained that the first inquiry is to determine if the claims "set out and circumscribe a particular area with a reasonable degree of precision and particularity."²³⁰ If they do, then the court turns to the many requirements of § 112, ¶ 1.²³¹ One of these is "determining whether the subject matter defined in the claims is described in the specification."²³² This "written description" requirement is "relatively simple to comply with and thus will ordinarily demand minimal concern on the part of the Patent Office."²³³ Again, as in *In re DiLeone*, the court nowhere states that the written description requirement is only relevant when dealing with issues of priority. In this case, it is unclear whether the claims were as originally filed, however, they were "consistently rejected under 35 U.S.C. § 112" which suggests they were rejected from the very beginning of prosecution before the USPTO.²³⁴

Likewise, in *In re Sus*, the court actually did reject claims, as originally filed, which were broader than the invention set forth in the written description.²³⁵ In so doing, the court explained that the purpose embodied in the written description requirement is that an "invention claimed shall be no broader than the invention set forth in the written description forming part of the specification."²³⁶ The court analyzed the appealed claims and found that they "fail[ed] to meet the requirements of 35 U.S.C. § 112 in that they [were] broader than the invention described in the written description

²²⁸ See *id.* at 1405–06.

²²⁹ *In re Moore*, 439 F.2d 1232 (C.C.P.A. 1971).

²³⁰ *Id.*

²³¹ *Id.*

²³² *Id.*

²³³ *Id.* at 1236.

²³⁴ *Id.* at 1234.

²³⁵ *In re Sus*, 306 F.2d 494, 497 (C.C.P.A. 1962).

²³⁶ *Id.*

thereof as set forth in the specification.”²³⁷ Further, “one skilled in this art would not be taught by these examples that all ‘aryl and substituted aryl radicals’ were properly within the subject matter *which appellants consider to be their invention*.”²³⁸ Although *In re Sus* may have been *initially* decided under §112, ¶ 2, Judge Rich himself noted it was more properly considered under the first paragraph.²³⁹ Tellingly, the only other portion of § 112 quoted by the court in *In re Sus* is the precise language of the written description requirement: “The specification shall contain a written description of the invention.”²⁴⁰

In summary, Chief Judge Rader’s assertion that Judge Rich resurrected a new written description requirement in 1967 for the sole purpose of policing priority finds no support in 131 years of precedent where the Supreme Court continued to apply the written description requirement after claims were added to patents.²⁴¹ Most interestingly, it was not even supported by Judge Rich in *In re Sus*, five years prior to his alleged creation of the doctrine.²⁴² Even in *Vas-Cath Inc. v. Mahurkar*, Judge Rich stated only that “the ‘written description’ requirement *most often* comes into play where claims not presented in the application when filed are presented thereafter;” he does not say it “*only*” comes into play in those situations.²⁴³ Finally, Chief Judge Rader’s position lacks support in the decisions of the CCPA immediately following the creation of this “new” written description doctrine.²⁴⁴

4. The CCPA and the Federal Circuit have Applied the Written Description Requirement to Original Claims

Chief Judge Rader, in *Enzo*, maintained that “[a]t no time did either the CCPA or the Federal Circuit purport to apply the

²³⁷ *Id.*

²³⁸ *Id.* at 504 (emphasis added).

²³⁹ *See In re Robins*, 429 F.2d 455, 457 n.8 (C.C.P.A. 1970).

²⁴⁰ *Sus*, 306 F.2d at 494 n.1 (quoting 35 U.S.C. § 112 (2006)).

²⁴¹ *See supra* note 220.

²⁴² *See Sus*, 306 F.2d at 497.

²⁴³ 935 F.2d 1555, 1560 (Fed. Cir. 1991) (emphasis added).

²⁴⁴ *See, e.g., In re Moore*, 439 F.2d 1232, 1235 (C.C.P.A. 1971); *In re Wertheim*, 541 F.2d 257, 262 (C.C.P.A. 1976); *In re Barker*, 559 F.2d 588, 592 (C.C.P.A. 1977).

equivalent new matter/written description rejections to original claims or other claims without priority problems.”²⁴⁵

First, simply because the CCPA or the Federal Circuit has not had the opportunity to apply a § 112 written description rejection to originally filed claims does not mean that § 112 written description has no application to originally filed claims. Courts “decide cases as they come to [them], based on the arguments raised, the decisions below, the law, the facts, and [their] best efforts,”²⁴⁶ so just because neither the CCPA nor the Federal Circuit was presented with the opportunity to strike down original claims under § 112 written description does not mean § 112 written description does not apply to original claims. Instead, at worst, it means the issue is undecided and at best, it means § 112 would apply to original claims as it would any other claim.²⁴⁷ Further, as stated above, the CCPA’s appellate jurisdiction over patent cases was far more limited than the current jurisdiction of the Federal Circuit.²⁴⁸ It is therefore entirely plausible that the Federal Circuit would face a situation calling for an application of an established doctrine at the CCPA to a new factual scenario.

Second, the CCPA has indeed applied the written description doctrine to originally filed claims in *In re Sus* and *In re DiLeone*, and the Federal Circuit applied written description to originally filed claims in *Fiers*.²⁴⁹ That the court did not have more opportunities before it to issue rejections under § 112 written description is both irrelevant and consistent with the CCPA’s limited jurisdiction of patent cases, hearing such cases only on appeal from the USPTO.²⁵⁰ Moreover, at that time in the court’s

²⁴⁵ *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 979 (Fed. Cir. 2002).

²⁴⁶ *Id.* at 974.

²⁴⁷ *See id.* at 971–72 (Lourie, J., concurring) (“As for the lack of earlier cases on this issue, it regularly happens in adjudication that issues do not arise until counsel raise them, and, when that occurs, courts are then required to decide them.”).

²⁴⁸ *See supra* notes 90, 93 and accompanying text.

²⁴⁹ *See In re DiLeone*, 436 F.2d 1404, 1405 (C.C.P.A. 1971); *In re Sus*, 306 F.2d 494, 497 (C.C.P.A. 1962); *see also Fiers v. Revel*, 984 F.2d 1164, 1170 (Fed. Cir. 1993) (“Revel thus urges that only similar language in the specification or original claims is necessary to satisfy the written description requirement. We disagree.”).

²⁵⁰ *See, e.g., In re Steinhauer*, 410 F.2d 411, 412 (C.C.P.A. 1969).

history, the USPTO was particularly imprecise in issuing rejections under 35 U.S.C. § 112.²⁵¹

The bottom line is that the Federal Circuit and the CCPA do not need to continuously apply the written description requirement to the fullest extent possible in order to prevent the written description requirement from becoming extinct. The written description requirement has been a part of the Patent Act since 1793, the Supreme Court has affirmed and reaffirmed its existence, and the doctrine still exists today.

5. The Holding in *In re Gardner* Has Been Misunderstood.

Chief Judge Rader cited cases such as *In re Gardner*, for the proposition that status as an original claim is all that is necessary to satisfy the written description requirement for § 112.²⁵² In *Gardner*, the court actually stated that “[c]laim 2, which apparently was an original claim, in itself constituted a description in the original disclosure equivalent in scope and identical in language to the total subject matter now being claimed.”²⁵³ Because the written description requirement is a fact-based inquiry which must be made in each case, this quote from *Gardner* should not be misconstrued as stating that every original claim automatically satisfies the written description requirement of § 112. Rather, in this case, claim 2 covered a total of seventeen compounds and delineated a subgenus.²⁵⁴ The USPTO’s § 112 rejection was based on the fact that only three out of the five possible R(1) substituents were specifically exemplified in the specification and no language was found in the specification corresponding to the subgenus.²⁵⁵ Effectively, the CCPA was saying that the level of detail necessary to satisfy the written description requirement was present in the

²⁵¹ See, e.g., *In re Robins*, 429 F.2d 455, 456 n.5 (C.C.P.A. 1970) (“Our consideration of this appeal would have been immeasurably simplified had the examiner merely referred to the specific language in § 112, or at least to the paragraph in which it is to be found.”); *In re Gay*, 309 F.2d 769, 772 (C.C.P.A. 1962) (“We have set forth the Patent Office position in some detail as we feel that it confuses, and in fact is in part contrary to, two of the several requirements of the first paragraph of 35 U.S.C. § 112.”).

²⁵² See *Enzo*, 323 F.3d at 979 (citing *In re Gardner*, 475 F.2d 1389, 1391 (C.C.P.A. 1973)).

²⁵³ *Gardner*, 475 F.2d at 1391.

²⁵⁴ *Id.*

²⁵⁵ *Id.*

claims as filed, which themselves constitute part of the specification.²⁵⁶ Furthermore, the court found sufficient evidence of enablement in the specification as well.²⁵⁷ This decision prevents the USPTO from issuing a hyper-technical rejection whereby a claim is rejected for lack of written description simply because the language of the claim was not copied, *in ipsius verbis*, into the specification before filing.

The CCPA's position in *Gardner* is consistent with Judge Lourie's majority opinion in *Enzo*.²⁵⁸ Enzo argued that the written description requirement was met as a matter of law because the claim language appeared *in ipsius verbis* in the specification.²⁵⁹ The court disagreed, finding that "[t]he appearance of mere indistinct words in a specification or a claim, even an original claim, does not necessarily satisfy [the written description] requirement."²⁶⁰ In both *Enzo* and *Lilly*, the court was "faced with a set of facts in which the words of the claim alone did not convey an adequate description of the invention."²⁶¹ In those situations, "regardless whether the claim appears in the original specification and is thus supported by the specification as of the filing date, § 112 ¶ 1 is not necessarily met."²⁶² "If a purported description of an invention does not meet the requirements of the statute, the fact that it appears as an original claim or in the specification does not save it. A claim does not become more descriptive by its repetition, or its longevity."²⁶³

6. The Claims Still Define the Invention

Judge Linn is skeptical of the separate written description requirement because "the claims—not the specification—define the invention."²⁶⁴ However, for an inventor to be entitled to patent

²⁵⁶ *See id.*

²⁵⁷ *See id.* at 1392.

²⁵⁸ *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 968 (Fed. Cir. 2002).

²⁵⁹ *Id.* (citing *Regents of Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1567 (Fed. Cir. 1997)).

²⁶⁰ *See Enzo*, 323 F.3d at 968.

²⁶¹ *Id.*

²⁶² *Id.*

²⁶³ *Id.* at 968–69.

²⁶⁴ *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 560 F.3d 1366, 1381 (Fed. Cir. 2009), *aff'd en banc*, 598 F.3d 1336 (Fed. Cir. 2010).

claims of any scope, he must first satisfy the written description requirement.²⁶⁵ “Interpretation of written description as this court has done furthers the goal of the law to have claims commensurate in scope with what has been disclosed to the public.”²⁶⁶ The claims serve as the absolute outer bounds of the scope of the invention. As part of the quid pro quo of the patent system, in exchange for the patent, the inventor must describe his particular invention commensurate with the scope he has claimed.²⁶⁷

7. A Specification May Enable One of Skill in the Art to Make and Use an Invention Without Providing Adequate Written Description

While it has been suggested that the distinction between the written description requirement and enablement requirement may not make a difference in some cases, there are a few situations where the specification at issue was found to satisfy the enablement requirement but not to satisfy the written description requirement.²⁶⁸

For example, in *Fields v. Conover*, Judge Rich explicitly stated that “a specification may provide adequate teachings of how to make and use subject matter which is subsequently claimed and yet fail to contain a written description thereof which complies with the first requirement of the first paragraph of 35 U.S.C. § 112.”²⁶⁹

Fields involved an interference between two parties on “substituted 4,10-dioxo-5-hydroxy-1,2,3,4,4a,9,9a,10-octahydro[-]anthracenes.”²⁷⁰ The only issue on appeal was whether the

²⁶⁵ See 35 U.S.C. § 112 (2006).

²⁶⁶ *Enzo*, 323 F.3d at 972 (Lourie, J., concurring).

²⁶⁷ See *In re Sus*, 306 F.2d 494, 497 (C.C.P.A. 1962) (“The public purpose on which the patent law rests requires the granting of claims commensurate in scope with the invention disclosed . . . the invention claimed shall be no broader than the invention set forth in the written description forming part of the specification.”).

²⁶⁸ See *Enzo*, 323 F.3d at 974 (“Perhaps there is little difference in electrical and mechanical inventions between describing an invention and enabling one to make and use it, but that is not true of chemical and chemical-like inventions.”). In fact, Judge Newman once conflated the two in *Kennecott Corp. v. Kyocera Int’l, Inc.*, 835 F.2d 1419, 1421 (Fed. Cir. 1987) (“The purpose of the description requirement is to state what is needed to fulfill the enablement criteria.”).

²⁶⁹ *Fields v. Conover*, 443 F.2d 1386, 1391 (C.C.P.A. 1971) (citing *In re Ahlbrecht*, 435 F.2d 908, 911 (C.C.P.A. 1971)).

²⁷⁰ *Id.* at 1386.

disclosure of the Conover application satisfied the written description and enablement requirements of 35 U.S.C. § 112.²⁷¹ The court found the enablement requirement was satisfied; one of ordinary skill in the art would be enabled, without undue experimentation, to make and use the claimed substance.²⁷² While the Conover application provides some “suggestions or guidance” to support the claim, this was not enough to satisfy the written description requirement.²⁷³ The suggestions and guidance provided in the application fell far short of the “full, clear, concise, and exact” written description requirement.²⁷⁴ Similar cases have also noted that compliance with enablement does not necessarily satisfy the written description requirement.²⁷⁵

C. Common Ground

The judges of the Federal Circuit have varying viewpoints on the legitimacy of a written description requirement in 35 U.S.C. § 112. Nevertheless, some common threads run through the opinions of the CCPA and the Federal Circuit notwithstanding the debate over the scope, or even the existence, of the written description requirement. For instance, all appear to agree on a few key concepts: 1) the inventor is not entitled to a patent broader than his true contribution to society in the form of his invention; 2) whether the patent is broader than the disclosed invention is a fact-based inquiry requiring a case-by-case assessment; 3) in the vast majority of cases, “enablement” and “written description” will rise and fall together. To sidestep the written description debate, this Section will refer generally to the “disclosure requirements of § 112.”

1. An Inventor Is Entitled to a Patent Commensurate in Scope with His Contribution to Society.

The disclosure requirements of § 112 satisfy the policy premise of the law “whereby the inventor’s technical/scientific advance is

²⁷¹ *Id.* at 1390.

²⁷² *Id.* at 1391.

²⁷³ *See id.* at 1392 (quoting *Biel v. Chessin*, 347 F.2d 898, 905 (C.C.P.A. 1965)).

²⁷⁴ *Fields*, 443 F.2d at 1392 (quoting *Ahlbrecht*, 435 F.2d at 911).

²⁷⁵ *See, e.g., Albrecht*, 435 F.2d at 911 (finding that a patent application for a chemical compound lacked a description “in full, clear, concise, and exact terms”).

added to the body of knowledge, as consideration for the grant of patent exclusivity.”²⁷⁶ The purpose of the disclosure requirements of § 112 is “to ensure that the scope of the right to exclude, as set forth in the claims, does not overreach the scope of the inventor’s contribution to the field of art as described in the patent specification.”²⁷⁷ The measure of the inventor’s contribution, for purposes of compliance with the disclosure requirements of § 112, is determined by what the patent teaches one of ordinary skill in the art.²⁷⁸ Hence, Judge Schall noted:

If a person of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate written description requirement is met.²⁷⁹

While the judges’ opinions differ as to what is encompassed within the disclosure requirements of § 112, and the appropriate grounds for rejection when those requirements are not met, it is well settled that “claims in an application which are broader than the applicant’s disclosure are not allowable.”²⁸⁰ Thus, the debate arises over what to call a rejection of this type and what portion of § 112 provides the standard.

2. Whether a Patent Exceeds the Scope of the Inventor’s Contribution to Society Is a Fact-Based Question Requiring Case-by-Case Assessment

In determining compliance with the disclosure requirements of § 112, “the primary consideration is *factual* and depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure.”²⁸¹ This inquiry will “necessarily vary depending on the nature of the invention

²⁷⁶ *Capon v. Eshhar*, 418 F.3d 1349, 1357 (Fed. Cir. 2005).

²⁷⁷ *Reiffin v. Microsoft Corp.*, 214 F.3d 1342, 1345 (Fed. Cir. 2000) (per curiam).

²⁷⁸ See *In re Goodman*, 11 F.3d 1046, 1050 (Fed. Cir. 1993) (quoting *In re Vaeck*, 947 F.2d 488, 496 (Fed. Cir. 1991)).

²⁷⁹ *In re Alton*, 76 F.3d 1168, 1175 (Fed. Cir. 1996).

²⁸⁰ *In re Moore*, 155 F.2d 379, 382 (C.C.P.A. 1946).

²⁸¹ *Union Oil Co. of Cal. v. Atl. Richfield Co.*, 208 F.3d 989, 996 (Fed. Cir. 2000) (quoting *In re Wertheim*, 541 F.2d 257, 262 (C.C.P.A. 1976)).

claimed.”²⁸² “Broadly articulated rules are peculiarly inappropriate in this area” and an analysis of each case on its facts must be made.²⁸³ Application of this doctrine will vary based on the relevant knowledge already in existence regarding the nature and scope of the invention.²⁸⁴ Thus, “[a]s each field evolves, the balance also evolves between what is known and what is added by each inventive contribution.”²⁸⁵

3. Most of the Times a Patent Fails to Satisfy the Enablement Requirement it Will Also Fail to Satisfy Judge Lourie’s Written Description Requirement

Judge Bryson, writing for the court in *LizardTech, Inc. v. Earth Resource Mapping, Inc.*, noted that the written description and enablement requirements “usually rise and fall together.”²⁸⁶ That is, “recitation of how to make and use the invention across the full breadth of the claim is ordinarily sufficient to demonstrate that the inventor possesses the full scope of the invention, and vice versa.”²⁸⁷ Even Judge Lourie, perhaps the strongest proponent of a separate written description requirement among the disclosure requirements in § 112, agrees that in many situations drawing a distinction between written description and enablement is unnecessary.²⁸⁸ It should come as no surprise, then, that in *Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co.*, Lilly also appealed the district court’s finding that the patent was enabled.²⁸⁹ Further,

²⁸² *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 963 (Fed. Cir. 2002) (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562 (Fed. Cir. 1991)).

²⁸³ *Wertheim*, 541 F.2d at 263.

²⁸⁴ *Capon v. Eshhar*, 418 F.3d 1349, 1357 (Fed. Cir. 2005).

²⁸⁵ *Id.* at 1358.

²⁸⁶ *LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 424 F.3d 1336, 1345 (Fed. Cir. 2005). *But see In re DiLeone*, 436 F.2d 1404, 1405 (C.C.P.A. 1971) (noting earlier cases recognizing that the written description requirement might not be met even when the patent claim satisfies the enabling requirement).

²⁸⁷ *LizardTech*, 424 F.3d at 1345.

²⁸⁸ *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 974 (Fed. Cir. 2002) (“Perhaps there is little difference in electrical and mechanical inventions between describing an invention and enabling one to make and use it, but that is not true of chemical and chemical-like inventions.”).

²⁸⁹ *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 560 F.3d 1366, 1369 (Fed. Cir. 2009), *aff’d en banc*, 598 F.3d 1336 (Fed. Cir. 2010).

Judge Linn, in concurrence, suggested that enablement likely was not satisfied.²⁹⁰

In summary, most agree that if a separate written description requirement is not recognized, the majority of cases will turn out the same.²⁹¹ In the cases where the written description requirement would have invalidated a patent, the patent will likely be invalid for failure to satisfy the enablement requirement.²⁹² It appears the fight is really over those few instances where the specification would enable one of ordinary skill in the art to practice the invention, yet the specification does not describe the invention in such a manner as to assure one of ordinary skill in the art that the inventor actually invented what he claimed.

CONCLUSION

The written description requirement traces its origin at least as far back as 1790 and has been consistently applied over the years to protect the public from overreaching inventors who claim to have invented what they have not. It is a doctrine which, like best mode and enablement, serves to later invalidate a patent when the inventor is disingenuous or insufficiently forthcoming to the public to secure the exclusive right to exclude. While certain judges on the Federal Circuit maintain diverging views of the written description requirement, they all agree on a few foundational aspects of the United States patent system. These aspects are embodied within the written description requirement as envisioned by a majority of Federal Circuit and CCPA judges and have been reaffirmed over the ages by the Supreme Court. In reaffirming the existence of an independent written description requirement, the Federal Circuit heeded binding Supreme Court precedent and the foundations upon which our Nation's patent system rests.

Our patent system rewards inventors, not those who merely come up with a research plan or a wish. An inventor is entitled to the right to exclude only over that which he has actually invented.

²⁹⁰ See *id.* at 1381 (“It may be, as Lilly argues, that such a claim can never be valid, since the specification cannot enable unknown methods.”).

²⁹¹ See *supra* notes 286–87 and accompanying text.

²⁹² See *supra* Part III.A.

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This ensures that future inventors are not dissuaded from improving existing inventions. The public is better served by a requirement that patent applications “possess[] that precision and clearness of statement with which one who proposes to secure a monopoly at the expense of the public ought to describe the thing which no one but himself can use or enjoy, without paying him for the privilege of doing so.”²⁹³ This requirement is the written description requirement contained within 35 U.S.C. § 112, ¶ 1, consistent with Judge Lourie’s expression of the written description requirement, and that reaffirmed by him in the court’s en banc resolution of *Ariad*.

²⁹³ Merrill v. Yeomans, 94 U.S. 568, 570 (1876).